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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/777,226	02/05/01	SELLERS C	A97128US

001200 TM02/0829
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EXAMINER	
DESIR,J	
ART UNIT	**PAPER NUMBER**
2614	5

DATE MAILED: 08/29/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/777,226	Applicant(s) SELLERS, CHARLES A.
	Examiner Jean W. Désir	Art Unit 2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-20 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-20 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4 .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Double Patenting

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 2, 4, 5, 6, 8, 15, 17 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-7 of prior U.S. Patent No. 6,184,943. This is a double patenting rejection.

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Allowing claim 1 would result in an unwarranted time wise extension of the monopoly previously granted for the invention defined by claims 1-5 of US Patent No. 6,184,943.

Allowing claim 3 would result in an unwarranted time wise extension of the monopoly previously granted for the invention defined by claims 2-4 of US Patent No. 6,184,943.

Allowing claim 7 would result in an unwarranted time wise extension of the monopoly previously granted for the invention defined by claim 5 of US Patent No. 6,184,943.

Allowing claim 14 would result in an unwarranted time wise extension of the monopoly previously granted for the invention defined by claims 6-7 of US Patent No. 6,184,943.

Allowing claim 16 would result in an unwarranted time wise extension of the monopoly previously granted for the invention defined by claim 7 of US Patent No. 6,184,943.

4. Claim 9 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 5 of U.S. Patent No. 6,184,943 in view of U.S Patent No. 5,353,075. Because claim 5 of U.S. Patent No. 6,184,943 discloses all the limitations of the claimed invention (claim 9); except the subject matter "... comprise a roller assembly" in claim 9. However, U.S Patent No. 5,353,075

discloses this subject matter, see Fig. 1 item 16 which is a roller assembly. An artisan would be motivated to combine the references to meet the claimed invention, because this combination would provide an adjustable system that would facilitate its moving or its storage. Therefore, the claimed invention would have been obvious to a person of ordinary skill in the art at the time the invention was made.

Claims 10, 13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,184,943 in view of U.S Patent No. 5,353,075. Because claim 1 of U.S. Patent No. 6,184,943 discloses all the limitations of the claimed invention (claims 10, 13); except the subject matter "... a polarizer filter" in claim 10 and "... a convex lens" in claim 13. However, U.S Patent No. 5,353,075 discloses these subject matter, see Fig. 4A and col. 4 lines 5-39 where these subject matter are disclosed. An artisan would be motivated to combine the references to meet the claimed invention, because this combination would produce enhanced images. Therefore, the claimed invention would have been obvious to a person of ordinary skill in the art at the time the invention was made.

Claims 11, 12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,184,943 in view of U.S Patent No. 5,353,075. Because claim 1 of U.S. Patent No. 6,184,943 discloses all the limitations of the claimed invention (claims 11, 12); except the subject matter "... a field emission display" in claim 11 and "... a liquid crystal display" in claim

12. However, U.S Patent No. 5,353,075 discloses these subject matter, see col. 3 lines 37-39 where these subject matter are disclosed. An artisan would be motivated to combine the references to meet the claimed invention, because this combination would provide improved quality picture. Therefore, the claimed invention would have been obvious to a person of ordinary skill in the art at the time the invention was made.

Claims 18, 19 are rejected for the same reasons as claims 11, 12.

Claim 20 is rejected for the same reasons as claims 13.

5. **Claims 1**, 3, 7, 9-14, 16, 18-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3, 7, 9-14, 16, 18-20 of copending Application No. 09/625,145. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of copending Application No. 09/625,145 discloses all the claimed subject matter of **Claim 1**, except **Claim 1** is not specifically said that the "optical system" is a focusing optical system. However, **Claim 1** discloses that the "optical system configured to discernably focus images". Thus, an artisan would have readily recognized that the "optical system" is a focusing optical system because it is configured to discernably focus images. Therefore, **Claim 1** is obvious to an artisan over claim 1 of copending Application No. 09/625,145.

Claims 3, 7, 9-14, 16, 18-20 are respectively rejected over claims 3, 7, 9-14, 16, 18-20 of copending Application No. 09/625,145 for the same reasons as claim 1.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 7, 9-14, 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Conner et al (5,353,075).

Claim 1:

the claimed "a base portion having a top surface;" is disclosed, see Fig. 1 item 12;

the claimed "and a projection display coupled to the base portion and movable between an open position and a closed position with respect to the base portion," is disclosed, see Fig. 1 item 18;

the claimed "an image generator for generating images; a projection surface for displaying images generated by the image generator;" is disclosed, see Fig. 1 item 20;

the claimed "and an optical system disposed between the image generator and the projection surface," is disclosed, see Fig. 5 which is an optical system disposed as claimed;

the claimed "the optical system configured to discernably focus images generated by the image generator onto the projection surface." is inherent to the Conner's system, because the optical system has optical components configured to produce enhanced images, see col. 4 lines 5-39.

Every claimed limitation has been disclosed, and the claimed invention is anticipated.

Claims 7, 9 are disclosed, see Fig. 1 item 16.

Claims 10, 13, 20 are disclosed, see col. 4 lines 5-39.

Claims 11, 12 are disclosed, see col. 3 lines 37-39.

Claim 14 is rejected for the same reasons as claim 1.

Claims 18, 19 are disclosed, see col. 3 lines 37-39.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 3, 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Conner et al (5,353,075) in view of Conner et al (4,917,465).

Claim 3:

Conner et al (5,353,075) discloses all the limitations of claim 3, as discussed in the above rejection of claim 1, except that the limitation "wherein the projection surface is formed of a plurality of rigid panels." is not explicitly disclosed by Conner et al (5,353,075). However, this limitation is met by Conner et al (4,917,465) – see Fig. 3, col. 4 lines 1-11, col. 6 lines 43-52.

Conner et al (5,353,075) in combination with Conner et al (4,917,465) render the claimed invention obvious. Conner et al (5,353,075) discloses a portable computer system incorporating a rear projection display. Conner et al (4,917,465) extends that system further by providing a plurality of rigid panels for the projection surface of the display system, as pointed out above. One with ordinary skill in the art would be motivated to combine the references to meet the claimed invention. And this modification would provide improved quality picture, see again Conner et al (4,917,465) col. 4 lines 1-11.

Therefore, the claimed invention would have been obvious to a person of ordinary skill in the art at the time the invention was made.

Claim 16 is rejected for the same reasons as claim 3.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ***Jean W. Désir*** whose telephone number is **(703) 308-9571**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ***Reinhard J. Eisenzopf,*** can be reached at **(703) 305-4711**.

11. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9314 (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

12. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

JWD
Aug. 25, 01

8-27-01

REINHARD J. EISENZOPF
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600